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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,320	01/29/2004	Marcelo Krygier	P-6505-US	1221
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EITAN, PEARL, LATZER & COHEN ZEDEK LLP 10 ROCKEFELLER PLAZA, SUITE 1001 NEW YORK, NY 10020				
			EXAMINER MASDON, DAVID T	
			ART UNIT 2188	PAPER NUMBER

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/766,320

Applicant(s)

KRYGIER, MARCELO

Examiner

David Masdon

Art Unit

2188

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings filed on 1-29-2004 have been approved by the examiner.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 13-16 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Line 1 of claims 13-16 read "An article comprising a storage medium having stored thereon instructions." The disclosure does not contain a specific definition for "article." The "article" could be interpreted to be the program product defined in paragraph 17, which includes carrier waves, and hence it includes non-statutory subject matter.

Appropriate action is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-8 and 11-16 rejected under 35 U.S.C. 102(e) as being anticipated by Bannai et al (US 6,647,428).

With regard to claim 1, Bannai et al discloses a method comprising: using one or more unused bits of an address argument of a command as an addressing mode field to determine whether said address argument is a byte address argument or a block address argument. [(address mode field for indicating "short" or "long" addressing mode) column 4, lines 16-31]

With regard to claim 2, Bannai et al discloses the method of claim 1 comprising: determining that the address argument is the byte address argument when the addressing mode field is zero. [(4 bits to indicate what type of addressing is used) column 4, lines 16-18] It is inherent that bit indication of address mode requires a field to show not only support for byte address, but also show support for block address. At the time of invention it would have been obvious to a person of ordinary skill in the art to have a flag or bit or a specific value (example 0 or 1) as an indicator to show a condition.

Claims 3, 15 and 16 rejected with same rationale as claim 2.

With regard to claim 4, Bannai et al discloses the method of claim 2 further comprising:

accessing a byte address within a memory unit according to the byte address argument if said address argument is a byte address argument. [(processor looks up address corresponding to address mode; whether long or short) column 4, lines 32-47]

Claim 5 rejected with same rationale as claim 4.

With regard to claim 6, Bannai et al discloses the method of claim 1, wherein using said one or more unused bits comprises using a least significant bit of said address argument. [(4 bits to indicate what type of addressing is used) column 4, lines 16-18] It is inherent that utilizing bits as an address mode field requires selected bits of the address argument to be reserved and used as the address mode field. At the time of invention it would have been obvious to a person of ordinary skill in the art to utilize any bit of an address argument as an address mode field, whether the bit was the least significant, most significant, 9th or 31st.

Claims 7, 11 and 12 rejected with same rationale as claim 6.

Claims 8, 13 and 14 rejected with same rationale as claim 1. Bannai et al discloses external memory (column 10, line 22) and a controller card (Fig. 12).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 9-10 rejected under 35 U.S.C 103 (a) as being unpatentable over Bannai et al (US 6,647,428) as applied to claim 8 above, and in view of Gonzalez et al (US 2005/0073884).

As per claims 9-10, Bannai et al does not disclose expressly apparatus of claim 8, wherein said memory unit is a multi media card (MMC) or a secure digital (SD) memory card. However, Gonzalez et al discloses using MultiMedia cards or Secure Digital cards. (page 1, section 0002)

Bannai et al and Gonzalez et al are analogous art because they are from same field of endeavor, namely storage and addressing modes. At the time of the invention it would have been obvious to a person of ordinary skill in the art to incorporate the multimedia and secure digital cards of Gonzalez et al into the system of Bannai et al. The motivation for doing so would have been manage the memory more efficiently. (Gonzalez et al; page 2, section 0009)

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hays et al	5,388,233
Fukushima et al	2002/0035718
Mitra et al	6,578,139
Ganmukhi et al	6,449,667
Robinson	4,131,881
Richardson et al	3,652,836

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Masdon whose telephone number is (571)272-6815. The examiner can normally be reached on Monday - Friday, 7am - 4:30pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mano Padmanabhan can be reached on (571)272-4210. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2188

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DM

Tuesday, March 28, 2006


3/31/06
MANO PADMANABHAN
SUPERVISORY PATENT EXAMINER